

REMARKS

I. Status of Claims

Claims 1-24, 29-67, 73-85, 161, and 162 are pending in this application. Claims 41-67 and 73-85 have been withdrawn from consideration. By this amendment, claims 25-28, 68-72, 86-120, 152-155, and 163 have been canceled without prejudice or disclaimer. Claim 9 has been amended, and withdrawn claim 41 has been amended to include the same limitations to the composition as claim 1. Support for this amendment may be found in the original specification and claims and thus adds no new matter.

Should the Examiner find the elected claims allowable, Applicants remind the Examiner of the obligation to consider rejoining the non-elected claims further to M.P.E.P. § 821.04, which states that when a product claim is found allowable, “withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined.” See M.P.E.P. § 821.04. If the Examiner does not rejoin the claims, Applicants reserve the right to file a divisional or continuation application(s) drawn to the non-elected subject matter.

II. Rejection under 35 U.S.C. § 112

Claim 9 is rejected by the Examiner as lacking antecedent basis for the limitation “anionic” in line 1.

Applicants have amended claim 9 to depend from claim 7, which recites that “said film forming polymers are chosen from anionic polymers.” Therefore, Applicants

respectfully submit that the limitation "anionic" in claim 9 has proper antecedent basis and request the withdrawal of this rejection.

III. Rejection under 35 U.S.C. § 102

Claims 1-2, 5, 10, 11, 25, 27-30, 37-39, and 161 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,660,838 ("Koga"). Office Action at page 2. Applicants respectfully disagree and traverse this rejection for at least the following reasons.

Applicants have canceled claims 25-28. As evidenced by the specification beginning at line 15 on page 15, derivatives of C₃ to C₅ monosaccharides may be used as the at least one compound of the present invention. Thus, derivatives of C₃ to C₅ monosaccharides represent an alternative embodiment to C₃ to C₅ monosaccharides. Claims 25-28 have therefore been canceled because they did not further limit the claims from which they depend. Claims 25-28 replaced the C₃ to C₅ monosaccharides of claim 1 with derivatives of C₃ to C₅ monosaccharides, including, for example, oligosaccharides derived from C₃ to C₅ monosaccharides. As one skilled in the art readily recognizes, oligosaccharides are not monosaccharides because they are comprised of at least two monosaccharides.

Therefore, a composition comprising an oligosaccharide and all of the elements in claim 1 but without a C₃ to C₅ monosaccharide is not a composition having all of the elements recited in claim 1.

The Examiner asserts that xylobiose is a C₃ to C₅ monosaccharide as recited in the present claims. See Office Action at page 2. However, Koga clearly teaches that "[x]ylobiose...is a disaccharide." Koga at col. 1, lines 44-58.

A reference must teach each element to anticipate the claim. See M.P.E.P. § 2131; *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."). Since Koga does not teach a composition comprising a C₃ to C₅ monosaccharide as recited in the present claims, Koga cannot anticipate the instant claims.

Accordingly, Applicants respectfully submit that the rejection is improper and request the withdrawal of this rejection for at least the foregoing reasons.

IV. Rejections under 35 U.S.C. § 103(a)

To establish a *prima facie* case of obviousness, there must be some objective teaching in the prior art, coupled with the knowledge generally available to one of ordinary skill in the art at the time of the invention, that would have motivated one of ordinary skill to modify or combine reference teachings with a reasonable expectation of success in obtaining the presently claimed invention. M.P.E.P. §§ 2143.01 and 2143.02.

Beck

Claims 1-4, 10-40, 161, and 162 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pub. No. 2002/0031483 ("Beck"). Office Action at pages 3-4. Applicants respectfully disagree and traverse this rejection for at least the following reasons.

The Examiner supports the rejection by noting that Beck teaches a hair treatment composition comprising sugars such as trioses, tetroses, and pentoses, and film-forming cationic polymers. *Id.* at pages 3-4.

Applicants respectfully disagree that Beck teaches or suggests the claimed invention. Evidence of a suggestion or motivation to modify or combine must be "clear and particular." *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Beck, in contrast, discloses the claimed limitations only in isolated passages throughout the specification. Beck teaches the use of sugars from trioses to hexoses without suggesting the desirability of compounds chosen from C₃-C₅ monosaccharides compared to C₆ saccharides, as required in M.P.E.P. § 2143.01. ("The prior art must suggest the desirability of the claimed invention.").

The composition of Beck is used "to feed and stimulate the central metabolic processes of the follicle, such as respiration of the hair follicle." Beck at par. [0003]. In fact, the sugar or carbohydrate of Beck, which is preferably citrate or glucose, is "taken up into hair follicles and used as an energy source." *Id.* at par. [0076]. Thus, the components in the composition of Beck are the reactants of a chemical reaction and do

not provide a durable non-permanent shaping or durable retention of a non-permanent shape as recited in the present claims.

Furthermore, there is no suggestion in Beck that these polymeric cationic compounds must be a film forming agent, much less that the composition comprises a film forming agent and at least one compound chosen from C₃-C₅ monosaccharides. To arrive at the claimed invention from Beck, which requires a sugar or carbohydrate that provides an energy source in the respiration of a hair follicle, one of ordinary skill in the art must pick from a myriad of possibilities without specific guidance to arrive at the claimed invention. Thus, Applicants respectfully submit that Beck's lack of specific guidance does not comply with the "clear and particular" standard articulated in *Dembiczak*. See also *In re Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002). ("The need for specificity pervades this authority").

Applicants respectfully submit that a *prima facie* case of obviousness has not been established. Accordingly, Applicants respectfully request withdrawal of this rejection.

Wisotzki

Claims 1, 2, 5, 6, 10-16, 24-40, 161, and 162 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,900,545 ("Wisotzki"). Office Action at pages 4-5. Applicants respectfully disagree and traverse this rejection for at least the following reasons.

The Examiner states that Wisotzki teaches hair compositions comprising at least mono- or disaccharides of pentoses or hexoses. Office Action at page 5. The

Examiner further alleges that Wisotzki teaches the use of sugars in the same amounts as claimed and that “absent showing evidence to the contrary, the hair compositions containing sugars of Wisotzki possess the ability to impart the claimed durable non-permanent shaping of hair fibers.” *Id.*

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. M.P.E.P. § 2143.03; *In re Royka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). The M.P.E.P. further states that “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03 (citing *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)).

Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness because the prior art does not teach or suggest each of the claim limitations.

As stated above, the Examiner alleges that Wisotzki teaches the use of sugars in the same amounts as claimed and that “absent showing evidence to the contrary, the hair compositions containing sugars of Wisotzki possess the ability to impart the claimed durable non-permanent shaping of hair fibers.” Office Action at page 5. The Examiner fails, however, to point to any teaching that the prior art teaches a composition wherein at least one film forming agent and at least one compound chosen from C₃ to C₅ monosaccharides “are present in an amount effective to impart a durable non-permanent shape to said at least one keratinous fiber or to durably retain a non-permanent shape of said at least one keratinous fiber,” as recited in the present claims.

Contrary to the Examiner's allegations, review of the entire disclosure of Wisotzki clearly demonstrates that Wisotzki does not teach a composition comprising at least one film forming agent and at least one compound chosen from C₃ to C₅ monosaccharides which are present in an amount effective to impart a durable non-permanent shape or to durably retain a non-permanent shape of at least one keratinous fiber.

First, Wisotzki teaches that the composition regenerates hair damaged by split ends by repairing the split ends. Wisotzki at col. 5, line 63 to col. 6, line 14. There is nothing within the disclosure of Wisotzki to suggest that the composition contains a film forming agent and a compound chosen from C₃ to C₅ monosaccharides in an amount capable of providing a durable non-permanent shaping effect.

Second, Wisotzki teaches that the composition is a rinsable hair treatment preparation, which may be removed from the hair by rinsing with water. *Id.* at col. 6, lines 23-27. A composition that is so easily rinsed from the hair with water cannot provide the durable non-permanent shaping or durable retention of a non-permanent shape as recited in the present claims.

Third, Wisotzki teaches that the hair regenerating treatment preparation does not have hair shaping capability because Wisotzki discloses that the hair regenerating treatment preparation can be added to a carrier including a hair setting preparation, such as a pomade, setting gel, or mousse. *Id.* at col. 3, lines 13-27 and col. 6, lines 20-23. Because the hair regenerating composition, which comprises a mono- or disaccharide, must be added to a hair setting carrier to achieve a hair setting effect, the

saccharide is not present in an amount effective to impart a durable non-permanent shape to a keratinous fiber or to durably retain a non-permanent shape of a keratinous fiber as recited in the present claims.

Thus, Wisotzki does not teach or suggest a composition comprising at least one film forming agent and at least one compound chosen from C₃ to C₅ monosaccharides which are present in an amount effective to impart a durable non-permanent shape to a keratinous fiber or to durably retain a non-permanent shape of a keratinous fiber as recited in the present claims. Because all of the elements recited in the present claims are not taught or suggested by the prior art, a *prima facie* case of obviousness has not been established.

Furthermore, Wisotzki teaches that “any mono- or disaccharides” may be used in the composition. As explained above, evidence of a suggestion or motivation to modify or combine must be “clear and particular.” *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). The broad disclosure of Wisotzki that any mono- or disaccharide may be used is not the specific guidance required by U.S. patent law because there is nothing within the disclosure of Wisotzki to motivate one skilled in the art to select a C₃ to C₅ monosaccharide as recited in the present claims.

Therefore, the rejection of the present claims as obvious over Wisotzki is improper and Applicants respectfully request the withdrawal of this rejection.

Keil and Wisotzki

Claims 1, 2, 5-16, 24-40, 161, and 162 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,690,924 (“Keil”) in view of U.S. Patent No.

4,900,545 ("Wisotzki"). Office Action at pages 6-7. Applicants respectfully disagree and traverse this rejection for at least the following reasons.

The Examiner states that Keil teaches hair treatment compositions but acknowledges that Keil "does not teach the instant monosaccharides." *Id.* at page 6. Thus, the Examiner relies on Wisotzki for teaching trioses, tetroses, and pentoses and film-forming cationic polymers. *Id.*

Applicants respectfully disagree that the references can be so combined. Keil describes the benefits of a chitosan-containing composition for use as a hair fixative. Keil at col. 1, line 56 to col. 2, line 7. Keil accentuates the importance of chitosan by noting that care properties of the composition were improved over compositions "without the simultaneous presence of the high molecular weight chitosonium-pyrrolidone carboxylate." *Id.* at col. 2, lines 1-7. Furthermore, Keil discloses the use of saccharides as a possible film-forming polymer. *Id.* at col. 2, line 52 to col. 3, line 7.

Wisotzki discloses a composition for fixing split ends that is rinsable. Wisotzki at col. 1, lines 2-48. Wisotzki also discloses a composition comprising panthenol and any mono- or disaccharide, as well as an optional ingredient, polyvinyl pyrrolidone, which is a film-forming compound. *Id.* at col. 2, lines 32-63.

Thus, one of ordinary skill in the art appreciating the benefits of chitosan advocated by Keil would not find it obvious to replace the chitosan with the sugars of Wisotzki. Moreover, by specifically teaching the use of chitosan, Keil teaches away from Wisotzki's composition.

Furthermore, the composition of Wisotzki is designed to be rinsable, whereas Keil's composition is a hair fixative, which remains on the hair.

Finally, Keil already discloses the use of a saccharide in the composition as the film-forming compound. Thus, it would not have been obvious to one skilled in the art to have added a sugar to the composition of Keil unless the sugar is *replacing* the film-forming compound of Keil. Even if such a substitution were obvious from the teachings of Keil and Wisotzki, the resulting composition would not have all of limitations recited in the present claims.

Because there is no suggestion to combine the references, Applicants respectfully submit that a *prima facie* case of obviousness has not been established. Accordingly, Applicants respectfully request withdrawal of this rejection.

V. Conclusion

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-24, 29-40, 161, and 162 in condition for allowance. Applicants submit that the proposed amendment of claim 9 does not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner. Applicants further submit that because withdrawn claim 41 has been amended to recite the same limitations to the composition as claim 1, claims 41-67 and 73-85 are also in condition for allowance and should be rejoined according to M.P.E.P. § 821.04.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicants' invention. It is respectfully submitted that the entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

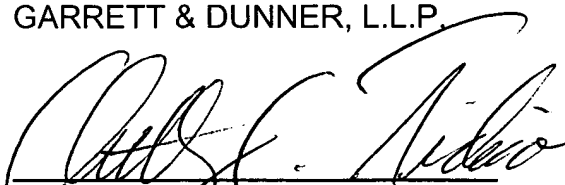
In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

By:


Anthony C. Tridico
Reg. No. 45,958

Dated: September 12, 2005